

GA



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,976	05/23/2001	Farzan Rastinejad	PC10228B	1819

7590 09/20/2005

Paul H. Ginsburg
Pfizer Inc
20th Floor
235 East 42nd Street
New York, NY 10017-5755

EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT	PAPER NUMBER
----------	--------------

1614

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,976

Applicant(s)

RASTINEJAD ET AL.

Examiner

Cybille Delacroix-Muirheid

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec. 3, 2004; March 21, 2005; 07/05/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-56 is/are pending in the application.
- 4a) Of the above claim(s) 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-42, 44, 45, 47 and 54 is/are rejected.
- 7) ☒ Claim(s) 43, 46, 48-53 and 55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

5.00

Detailed Action

The following is responsive to applicant's amendment/remarks received Dec. 3, 2004, March 21, 2005 and Jul. 5, 2005.

Claims 1-25 are cancelled. No new claims are added. Claims 26-56 are currently pending.

The previous claim objections set forth in paragraph 1 of the office action mailed June 3, 2004 are withdrawn in view of applicant's amendment(s) and remarks contained therein.

The previous claim rejection under 35 USC 112, first paragraph, set forth in paragraph 2 of the office action mailed June 3, 2004 is withdrawn in view of applicant's amendment(s) and remarks contained therein.

The previous rejections of claims 38, 41, 42, 43 under 35 USC 112, second paragraph, set forth in paragraphs 3 and 5-8 of the office action mailed June 3, 2004 are withdrawn in view of applicant's amendment(s) and remarks contained therein. **PLEASE NOTE:** the rejection of claim 28 under 35 USC 112, second paragraph (paragraphs 3-4 of the office action mailed June 3, 2004) is maintained. Claim 28 continues to recite "measurement" which has no antecedent basis in the claim.

Applicant's arguments traversing the previous claim rejection under 35 USC 102(e) and the previous claim rejection under 35 USC 103(a), set forth in paragraphs 9-10 of the office action mailed June 3, 2004 have been considered but are not found to be persuasive.

Said rejections are maintained essentially for the reasons given previously in the office action mailed June 3, 2004 with the following additional comment.

Applicant argues that in the present invention, applicant has made the pioneering discovery that small organic compounds present in doses that are small and safe enough to be

Art Unit: 1614

administered to living patients can successfully rescue the conformation of p53 protein in order to facilitate treatment of cancer. Applicant further argues,

“The present invention defines methods (see independent Claim 26) which include the obvious practical limitation that the identified compounds are actually "useful in the treatment of cancer" and can usefully bind to p53 under physiological conditions. Compound X (Example 3, page 47) is such a compound. The Welch disclosure is readily seen as being not particularly relevant to the discovery of compounds that are useful as drugs, particularly those that likely bind to specific sites in the p53 protein. Rather the Welch disclosure relates to the well recognized field that proteins can be solubilized or "stabilized" by soaking in them in solvents, at immense concentrations of solvents and usually via generalized solvation effects.”

“The Welch disclosure does not pertain to providing specific compounds useful as safe low dose pharmaceuticals, i.e. clinically useful sub-micromolar quantities. Simply stated, the generalized history of protein solvation experiments has nothing to do with the development of useful pharmaceuticals, nor can it, in any way, provide motivation for such other inventions or even remotely suggest predict that such useful inventions would be remotely possible. Welch fails, as it must, to suggest specific binding effects useful at physiological concentrations. It must be reiterated that the cells in patients' living bodies are very different from the cells in the in vitro cultures of Welch.”

Said arguments have been considered but are not found to be persuasive. The examiner respectfully submits that applicant's arguments are not commensurate in scope with the claimed method. Applicant's claims are directed to a method of identifying organic non-peptide compounds useful in the treatment of cancer. They do not require the therapeutic treatment of a patient suffering from cancer.

Moreover, the phrase at line 2 of claim 26, “useful in the treatment of cancer” is essentially an intended use limitation. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. Court held that the intended use of hair curling was of no

Art Unit: 1614

significance to the structure and process of making.). In this case, the intended use of treating cancer with the identified non-peptide organic compound is of no significance to the method of identifying the organic non-peptide compound. It is for these reasons as well as those submitted previously in the office action mailed June 3, 2004 that the rejections are maintained.

Claim 43 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Claims 26-42, 44-45, 47, 54 stand rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Cybill Delacroix-Muirheid** whose telephone number is **571-**

Art Unit: 1614

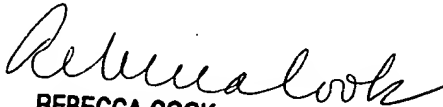
272-0572. The examiner can normally be reached on Mon-Thurs. from 8:30 to 6:00 as well as every other Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher Low**, can be reached on **571-272-0951**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CDM 

Sep. 19, 2005


REBECCA COOK
PRIMARY EXAMINER
GROUP ~~1200~~ 1614